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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants : JIN, et al.
U.S. Serial No.: 09/886,555
Filed : June 21, 2001
For : STABLE POLYMER AQUEOUS/AQUEOUS EMULSION
SYSTEM AND USES THEREOF

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October 15, 2002

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMMUNICATION IN RESPONSE TO
THE SEPTEMBER 12, 2002 OFFICE ACTION

This Communication is submitted in response to the September 12, 2002 Office Action issued by the United States Patent and Trademark Office in connection with the above-identified application. A response to the September 12, 2002 Office Action is due October 12, 2002. Since October 12, 2002 falls on a Saturday, the response is due October 14, 2002. However, October 14, 2002 is a Federal holiday, so the response is due the next business day, i.e., October 15, 2002. Accordingly, this Communication is being timely filed.

RESPONSE TO THE RESTRICTION REQUIREMENT

The Examiner to whom the application has been assigned has restricted the invention into four groups. Applicants respectfully traverse the above restriction requirement. In response, Applicants would like to elect, with traverse, Group I, directed to claims 1, 3, and 6-11 for further prosecution of the application.

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Applicants respectfully contend for that the Examiner has failed to establish a *prima facie* case that the restriction is proper. As stated in MPEP §803, "an application may properly be restricted to one of two or more inventions only if they are able to support separate patents and they are either independent or distinct. If the search of the entire application can be made without serious burden, the examiner **must** examine it on the merits, **even though** it includes claims to independent or distinct inventions." (Emphasis added.) MPEP §803. "There are two criteria for a proper requirement for restriction between two patentable distinct inventions: (A) The inventions must be independent or distinct as claimed; **and** (B) There must be a serious burden on the Examiner if restriction is required." (Emphasis added, citations omitted.) *Id.* Applicants urge that the Examiner has not offered any evidence to satisfy either parts (A) or (B), both of which require a showing for the restriction to be proper.

Inventions are not Independent under MPEP §806.04(A). MPEP §806.04(A) is illustrative of independent inventions: "[A]n article of apparel such as a shoe and a locomotive bearing would be an example." In striking contrast to this example, all of the pending claims are directed to an "emulsion."

In conclusion, the Examiner has failed to meet either prong of the two-part showing required under MPEP §806.04(A) for independent inventions, and therefore restriction between Groups I, II, III, and IV is improper.

The Examiner has not, and cannot, demonstrate a "serious burden" because a single search can be done for all four Groups. A search for an emulsion, a search for Claim 1, a stable aqueous/aqueous emulsion system which is prepared with a hydrophilic polymer (Group I), would reveal references for a

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method of making an emulsion (Group II); a method for encapsulating a protein (Group III); and a diagnostic kit (Group IV). Applicants respectfully contend that the Examiner has not demonstrated "a serious burden." Therefore, Applicants request reconsideration and withdrawal of the present restriction requirement.

If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is given to charge the amount of any such fee to Deposit Account No. 50-1891.

Respectfully submitted,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.	
<u>Albert Wai Kit Chan</u>	<u>10/15/02</u>
Albert Wai-Kit Chan	Date
Reg. No. 36,479	